

REMARKS

Claims 1, 2, 4 and 5 are pending. No claims are currently added or cancelled. Claim 1 is currently amended for purposes of clarification and without adding new matter. Support for the amendment to claim 1 may be found, for example, in Applicant's specification at page 6, lines 2-30, and more particularly, lines 24-30. Applicant believes that the amendments to the claims place the application in condition for allowance. Applicant respectfully requests reconsideration of the application and claims as presently amended, and prompt allowance of all pending claims, in view of the following arguments.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by and unpatentable over Takeda et al. (WO 03/064552 A1). Applicant has submitted herewith a timely-filed Declaration from Yorinobu Takamatsu, a named inventor on both the Takeda et al. reference and the presently pending application, which establishes that any invention relating to a heat resistant masking tape as presently claimed that was disclosed but not claimed in Takeda et al. was derived from the named inventors of the presently pending application, and is thus not the invention "by another" under 35 U.S.C. § 102(e). Thus, Applicant respectfully submits that the rejection of claims 1, 2, 4, and 5 under 35 U.S.C. § 102(e) as allegedly being anticipated by Takeda et al. has been overcome, and should be withdrawn. Reconsideration and withdrawal of the rejection over Takeda et al. under 35 U.S.C. § 102(e) is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious and being unpatentable over Yamanaka et al. (US 2003/0124346) in view of Zhou et al. (US 2002/0132111). Claim 2 additionally stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious and unpatentable over Lehmann et al. (US 4,038,454) in view of Zhou et al. (US 2002/0132111) and Yamanaka et al. (US 2003/0124346). Claims 1, 4, and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious and unpatentable over Lehmann et al. (US 4,038,454) in view of Zhou et al. (US 2002/0132111). Applicant respectfully disagrees with the rejections of the claims based on Yamanaka et al. in view of Zhou et al., and Lehmann et al. in view of Zhou et al. and further in view Yamanaka et al., for at least three reasons.

First, Applicant has presently amended independent claim 1 to include a limitation: further wherein a first surface of the heat resistant backing film layer is surface treated, and further wherein a **second surface of the heat resistant backing film layer opposite the first surface is treated with a release agent**;

Applicant respectfully contends that none of Yamanaka et al., Zhou et al., or Lehmann et al. have been shown by the Patent Office to disclose, teach or suggest that the second surface of the heat resistant backing film layer opposite the first surface is **treated with a release agent**, as Applicant presently claims. Thus, Applicant respectfully submits that the Patent Office has at least failed to properly provide a combination of prior art references that teaches or suggests all-limitations of Applicant's presently claimed invention, as required to maintain an alleged *prima facie* case of obviousness under 35 U.S.C. § 103(a).¹ For at least this reason, the rejections of claims 1, 2 and 4 under 35 U.S.C. § 103(a) as allegedly being obvious and unpatentable over Yamanaka et al. in view of Zhou et al., claim 2 as allegedly being obvious and unpatentable over Lehmann et al. in view of Zhou et al. and Yamanaka et al., and claims 1 and 4 as allegedly being obvious and unpatentable over Lehmann et al. in view of Zhou et al., has been overcome and should be withdrawn.

Second, with particular reference to the rejection of claims 1, 2, 4 and 5 under 35 U.S.C. § 103(a) as allegedly obvious and unpatentable over Yamanaka et al. in view of Zhou et al., Applicant understands Yamanaka et al. to disclose or teach only aqueous dispersion type copolymers wherein “[t]he monomer mixture... is polymerized in an aqueous medium in the presence of ingredient D, which is at least one nonionic surfactant and/or at least one anionic surfactant each **having an ethylenic double bond** to thereby obtain an aqueous dispersion type acrylic copolymer.”² Yamanaka et al. expressly discloses that “[i]ngredient (D) not only functions as an emulsifying agent during the polymerization of the monomer mixture, **but also is incorporated into the copolymer** and serves to improve adhesive properties, inhibit the adhesive force from increasing with time, and facilitate adhesive removal after application.”³

¹ See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986).

² See e.g. US 2003/0124346 A1, ¶[0025] (emphasis added).

³ *Id.* (emphasis added).

Thus, with particular reference to the rejection of independent claim 5, which includes a product by process limitation, the Patent Office's reliance on *In re Thorpe* for the proposition that “[i]f the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claims is unpatentable, even though the prior product was made by a different product”⁴ is misplaced, as Yamanaka et al. **admits** that the polymerized copolymer **is incorporated into the copolymer and has a material effect on the adhesive properties of the resulting copolymer.** Therefore, Applicant respectfully submits that at least the rejection of Applicant's independent claim 5 based on any combination of Yamanaka et al. with any other cited reference is improper, where, as here the rejection is improperly founded on the rebutted proposition that the aqueous dispersion type copolymers taught by Yamanaka et al. are the same product as the polymer Applicant claims in independent claim 5.

Furthermore, with reference to the rejection of claims 1, 2, 4 and 5 under 35 U.S.C. § 103(a) as allegedly obvious and unpatentable over Yamanaka et al. in view of Zhou et al., Applicant understands Zhou et al. to disclose only nonaqueous acrylic solution polymers applied by coating to a film backing, which the Patent Office alleges may preferably include a primer treatment when used with polyethylene naphthalate films.⁵ Applicant respectfully contends that to the extent that Zhou et al. allegedly disclose or teach a primer treatment, those alleged primer treatments have only been shown as suitable for use in coating nonaqueous acrylic solution polymers as specifically disclosed by Zhou et al. Applicant further respectfully contends that the Patent Office has not shown that such alleged primer layers are suitable for use in coating an aqueous dispersion type copolymer as disclosed by Yamanaka et al.

In particular, Applicant respectfully contends that one of ordinary skill in the art of coating and formulating pressure sensitive adhesive polymers would understand that aqueous dispersions and nonaqueous solutions will exhibit different contact angles when coated to backings and subsequently dried, and further, that an aqueous coating will not properly wet and form a film on an oleophilic or hydrophobic primer layer selected for use with a nonaqueous coating composition. Thus, Applicant respectfully submits that one of ordinary skill in the art

⁴ *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

⁵ See e.g. US 2002/0132111 A1, ¶¶[0021]-[

would not be properly motivated to combine the alleged primer layers disclosed by Zhou et al. as suitable for nonaqueous coatings, with the aqueous dispersion type copolymer as disclosed by Yamanaka et al., and further, that the skilled artisan would not have a reasonable likelihood of success in obtaining Applicant's presently claimed nonaqueous pressure-sensitive adhesive layer disposed on the treated surface of the heat resistant backing film layer even if such a combination were made. For at least these reasons, the rejection of claims 1, 2, 4 and 5 under 35 U.S.C. § 103(a) as allegedly being obvious and unpatentable over Yamanaka et al. in view of Zhou et al., has been overcome and should be withdrawn.

Third, with particular reference to the rejection of Applicant's independent claim 5 under 35 U.S.C. § 103(a) as allegedly obvious and unpatentable over Lehmann et al. in view of Zhou et al., Applicant respectfully notes that the Patent Office relies upon Example 4 of Lehmann et al. as allegedly disclosing the identical product as Applicant's claimed product by process limitation. Applicant expressly claims that the polymer is formed from a monomer mixture **consisting essentially of three components**: an alkyl (meth)acrylate with an alkyl group having 4 to 15 carbon atoms, glycidyl(meth)acrylate and (meth)acrylic acid. However, Applicant understands Lehmann et al. Example 4 to teach a **polymer formed from four components: two alkyl acrylates** with an alkyl group having 4 to 15 carbon atoms (i.e. 2-ethylhexyl acrylate and n-butyl acrylate), glycidyl(meth)acrylate and acrylic acid.

Furthermore, Applicant respectfully contends that it would be well known to one of ordinary skill in the art of pressure sensitive adhesive polymers that polymerization of a combination of two alkyl acrylates will necessarily produce a polymer composition having a different glass transition temperature, and therefore different tackiness and hence adhesive properties, than polymerization of either alkyl acrylate alone. Applicant respectfully submits that it has rebutted the Patent Office's contention that the polymer disclosed by Lehmann et al. is the same polymer as claimed in Applicant's claim 5. Therefore, Applicant respectfully submits that at least the rejection of Applicant's independent claim 5 based on Lehmann et al. is improper, where, as here the rejection is improperly founded on the rebutted proposition that the adhesive copolymer taught by Lehmann et al. Example 4 is the same product as the polymer Applicant claims in independent claim 5. For at least this reason, the rejection of claim 5 under

35 U.S.C. § 103(a) as allegedly being obvious and unpatentable over Lehmann et al. in view of Zhou et al. has been overcome and should be withdrawn.

CONCLUSION

For all of the foregoing reasons, Applicant respectfully submits that it has overcome each of the rejections of the claims for alleged anticipation under 35 U.S.C. § 102(e) and alleged obviousness under 35 U.S.C. § 103(a). Reconsideration of all pending claims as currently amended is respectfully requested. In view of the above, it is submitted that the application is in condition for allowance. Allowance of all pending claims at an early date is solicited. In the event that the Office disagrees, Applicant respectfully requests a telephone interview with the Examiner to more fully understand the Examiner's position and advance this case to issuance.

Respectfully submitted,

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